

Hearing:
December 10, 1998

Paper No. 13
HRW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG 11,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 800-Gifthouse, Inc.

Serial No. 75/016,128

Thomas M. Galgano of Galgano & Burke for 800-Gifthouse,
Inc.

Matthew C. Kline, Trademark Examining Attorney, Law Office
104 (Sidney I. Moskowitz, Managing Attorney).

Before Simms, Quinn and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

800-Gifthouse, Inc. has filed an application to
register the mark WORLD'S FAVORITE FLORIST for "receiving
orders for flowers and floral products, transmitting them
to and/or causing them to be filled by participating

florists in the vicinity of the recipient" in Class 35 and "retail flower and plant store services" in Class 42.¹

Registration has been finally refused under Section 2(e)(1), on the ground that the proposed mark is merely descriptive of the identified services. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held.

As a preliminary matter, at the oral hearing applicant supplied the Board with a copy of a request to suspend the appeal and remand the application to the Examining Attorney for consideration of newly submitted evidence, which request was said by applicant's counsel to have been filed with the Office on February 17, 1998. Although this request was not in the application file, and thus had not previously been reviewed by the Board, the request has now been taken under consideration and is denied.

Applicant attached to its appeal brief copies of third-party registrations and applications which the Examining Attorney objected to both as being untimely under Rule 2.142(d) and as being improper copies, in that they were printouts from the database of a private company. Applicant, in response, filed its request to suspend and to

¹ Serial No. 75/016,128, filed October 31, 1995, based on a bona fide intention to use the mark in commerce. A disclaimer has

reopen prosecution before the Examining Attorney so that its newly submitted soft copies of third-party registrations could be considered by the Examining Attorney.

Clearly this is contrary to the purpose of Trademark Rule 2.142(d), which requires that the record be complete before the filing of an appeal. Newly found evidence may provide a basis for a remand to the Examining Attorney, but not tardily provided copies of third-party registrations which have long been available. Not only is the request denied, but the Examining Attorney's objection to the copies originally filed with applicant's brief is upheld and the third-party registrations have not been considered in this appeal.²

Turning to the refusal at hand, the Examining Attorney has taken the position that the proposed mark is laudatorily descriptive of applicant's florist services and thus equivalent to any other merely descriptive term under

been entered of the word "FLORIST."

² For the sake of completeness, even if these registrations had been considered, our decision would have remained the same. The third-party registrations are for "World's Favorite" marks which are not nearly so closely related to the services with which they are being used. For example, in Reg. No. 1,733,632, it is the mark THE WORLD'S FAVOURITE VACATIONS which is being used in connection with air transportation services, not WORLD'S FAVORITE AIRLINE. In Reg. No. 1,091,995 it is the mark WORLD'S BEST

Section 2(e)(1). He likens the proposed mark WORLD'S FAVORITE FLORIST to the phrases AMERICA'S BEST POPCORN and AMERICA'S FAVORITE POPCORN which were held by the Board to be no more than laudatory epithets describing the claimed quality and popularity of the product with which they were being used, and thus merely descriptive under Section 2(e)(1). See *In re Wileswood, Inc.*, 210 USPQ 400 (TTAB 1978).

Applicant argues that the term WORLD'S FAVORITE is not analogous to the term AMERICA'S FAVORITE, or AMERICA'S BEST, in that WORLD'S does not convey the same commercial impression as AMERICA'S. Applicant contends that, although the term AMERICA'S may be primarily geographic and descriptive in nature, the term WORLD'S is too broad to suggest any identifiable unit or place of origin or to be descriptive of the bounds within which a mark functions, citing *World's Carpets Inc., v. Dick Littrell's New World Carpets*, 438 F.2d 482, 168 USPQ 609 (5th Cir. 1971). According to applicant, the phrase WORLD'S FAVORITE is only suggestive that applicant is renowned for its florist services, a type of trade puffery that has been found registrable on the Principal Register in the past.

COOKED SECRET being used for restaurant services, not WORLD'S BEST RESTAURANT.

In its recent decision in *In re Boston Beer Co. L.P.*, 47 USPQ2d 1914 (TTAB 1998), the Board once again reviewed the registrability of laudatory designations or expressions used to tout the superior qualities of an applicant's product. The designation THE BEST BEER IN AMERICA was found to be no more than a descriptive claim of superiority with respect to applicant's beer, in the same sense that AMERICA'S BEST POPCORN and AMERICA'S FAVORITE POPCORN had previously been held to be only laudatory, comparative, descriptive designations. Even though there was no means by which any single beer was actually awarded the title of "best beer in America," the claim of superiority in itself, referred to as "trade puffery" by the Board, was deemed descriptive.

Applicant is also simply touting or describing its florist services as being superior in popularity to the services of others. We have no idea, nor would purchasers, whether there is any factual basis for this claim. Instead, this is trade puffery, pure and simple. There is no element of suggestiveness, as argued by applicant, only a boastful claim of the superior popularity of applicant's services with the purchasing public.

Furthermore, we fail to see how a viable distinction can be made on the basis of using the word WORLD'S, as

opposed to AMERICA'S. Both in the *Wileswood* case and in *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984)[AMERICA'S FRESHEST ICE CREAM], the inclusion of the term AMERICA'S was found to merely reinforce the laudatory nature of the designation, or, in other words, to simply add to the boastfulness of the claim. Applicant's use of the word WORLD'S is for the same purpose. The holding in *World's Carpets Inc. v. Dick Littrell's New World Carpets*, *supra*, was in reference to the geographic descriptiveness of the term WORLD in itself, which is not the issue here. When used in a laudatory sense to describe the realm of the claimed superiority, WORLD'S has the same effect as AMERICA'S, albeit with broadened boundaries. In *In re Royal Viking Line A/S*, 216 USPQ 795, 797 (TTAB 1982), the Board held the words WORLD CLASS merely descriptive for cruise ship services, stating that these words were used "in a laudatory manner much like one would use 'first class' or 'world's finest' or 'world's best,'" to convey to purchasers the superior nature of applicant's services. We see no difference in the use here by applicant of the term WORLD'S, as part of the designation WORLD'S FAVORITE FLORIST, to tout the superiority of its florist services.

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Decision: The refusal to register under Section
2(e)(1) is affirmed.

R. L. Simms

T. J. Quinn

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

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